

**FILED**

**SEP 17 2007**

RICHARD W. WIEKING  
CLERK, U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

Henry C. Bunsow (SBN 60707)  
bunsowh@howrey.com  
Denise De Mory (SBN 168076)  
demoryd@howrey.com  
Brian A.E. Smith (SBN 188147)  
smithbrian@howrey.com  
HOWREY LLP  
525 Market Street, Suite 3600  
San Francisco California 94105  
Telephone: (415) 848-4900  
Facsimile: (415) 848-4999

Attorneys for Defendant  
AuthenTec, Inc.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND DIVISION

ATMEL CORPORATION, a Delaware  
corporation; ATMEL SWITZERLAND, a  
corporation; ATMEL FRANCE, a corporation;  
and ATMEL SARL, a corporation,

Plaintiffs,

v.

AUTHENTEC, INC., a Delaware corporation,  
Defendant.

Case No. 06 CV 2138 CW

**REQUEST FOR INTERNATIONAL  
JUDICIAL ASSISTANCE PURSUANT TO  
THE HAGUE CONVENTION THE TAKING  
OF EVIDENCE ABROAD IN CIVIL OR  
COMMERCIAL MATTERS  
(HAGUE CONVENTION #20)**

**IDENTITY AND ADDRESS OF THE APPLICANT:**

Honorable Elizabeth Laporte  
United States District Court for the Northern District of California  
San Francisco Division  
Courtroom E, 15<sup>th</sup> Floor  
450 Golden Gate Avenue  
San Francisco, CA 94102

**CENTRAL AUTHORITY OF THE RECEIVING STATE:**

Präsidentin des Oberlandesgerichts München  
Prielmayerstrasse 5  
80097 München  
DEUTSCHLAND  
Tel.: +49 (89) 5597-1  
Fax: +49 (89) 5597-3575

In conformity with Article 3 of Hague Convention #20, the undersigned applicant has the honor and judicial authority to submit this request on behalf of the Defendants in the above-entitled action.

The United States District Court, for the Northern District of California, by and through the Honorable Elizabeth Laporte, presents its compliments to the judicial authorities of Germany, and requests international judicial assistance to obtain evidence to be used in a civil proceeding before this court in the above-captioned matter.

A trial on this matter is currently scheduled to take place in California. This court requests the assistance described herein as necessary in the interests of justice.

Below are the names of all parties in this matter and their representatives:

Party	Legal Representative
<b>PLAINTIFFS:</b> Atmel Corporation Atmel Switzerland Atmel France Atmel SARL By and through counsel: Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000	Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000
<b>DEFENDANTS:</b> AuthenTec, Inc. By and through counsel: Denise De Mory, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900	Henry C. Bunsow, Esq. Denise De Mory, Esq. Brian A.E. Smith, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900 Fax (415) 848-4999

#### **REPRESENTATIVE TO ACT ON BEHALF OF DEFENDANTS:**

It is requested that should contact or correspondence with Defendants in this matter be required, the following individual is appointed in this matter to represent Defendants:

Denise De Mory, Esq.  
 Howrey LLP  
 525 Market Street, Suite 3600  
 San Francisco, California, 94105  
 United States of America  
 Telephone (415) 848-4900  
 Fax (415) 848-4999

**ENTITY FROM WHOM EVIDENCE IS REQUESTED:**

**Siemens AG**  
 Wittelsbacherplatz 2  
 D-8033 Munich  
 Federal Republic of Germany

It is believed that **Siemens AG** is a business entity registered to do business in Germany.

**SUBJECT MATTER AND RELATIVITY OF THIS REQUEST:**

Atmel filed a complaint against AuthenTec, Inc. ("AuthenTec") in the United States District Court for the Northern District of California alleging patent infringement ("Atmel Lawsuit"). The two patents asserted against AuthenTec relate to fingerprint sensors. Based on documents that AuthenTec has received in this case, AuthenTec believes that the two patents asserted by Atmel may be invalid due to inventorship by another and/or an on sale bar. AuthenTec believes that evidence of prior inventorship and/or an on sale bar is in the possession, custody and control of **Siemens AG**, in part, because Atmel has produced documents authored by the inventor of the asserted patents referencing **Siemens AG**. The requested documents and information from **Siemens AG** are therefore relevant to and necessary for trial of this case.

**SPECIFIC REQUESTS:**

The District Court respectfully requests that these documents and information be produced quickly, but if at all possible within 30 days after receipt of this request, at a place and time designated by the German court having competent jurisdiction over this request.

In view of the foregoing, we therefore request, in the interest of justice, that you issue an order for the acquisition of the evidence requested below, in accordance with the laws and procedures of the courts of Germany, and summon the appropriate employee, director, officer or other appropriate representative of **Siemens AG**, in possession or control of the evidence requested, to submit the evidence requested to a duly appointed authority in Germany, in an expeditious manner, for examination by the below signed authority.

**EVIDENCE TO BE OBTAINED:****A. Definitions.**

In addition to the abbreviated terms identified above, for the purposes of this request:

1 (1) the terms “you” and “your” mean **Siemens AG**, including, without limitation, all  
2 predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships  
3 and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting  
4 on their behalf;

5 (2) the term “Thompson-CSF” means Thomson-CSF and all predecessors (merged, acquired, or  
6 otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, including but  
7 not limited to IDmatics, Laboratoire Central de Recherches, and Thomson-CSF Semiconducteurs  
8 Specifiques, and all directors, officers, agents, employees, attorneys, and other persons acting on their  
9 behalf;

10 (3) the term “Atmel” means Atmel Corporation, Atmel SARL, Atmel France, Atmel  
11 Switzerland, Atmel Grenoble and all predecessors (merged, acquired, or otherwise), successors,  
12 subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents,  
13 employees, attorneys, and other persons acting on their behalf.

14 (4) the term “Thales” means the Thales Group and all predecessors (merged, acquired, or  
15 otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all  
16 directors, officers, agents, employees, attorneys, and other persons acting on their behalf.

17 (5) the term “fingerprint sensor” means all mechanical, electronic, optical, electro-optical,  
18 capacitive, reflection, RF, pressure, temperature, ultrasound, and micro-electro-mechanical systems  
19 and devices designed to read a fingerprint for authenticating individuals, including but not limited to  
20 all prototypes and experiments related to such sensors and further including but not limited to strip  
21 and/or swipe sensors;

22 (6) the term “fingerprint sensing technologies” means all hardware, software, and other  
23 components that may be incorporated into or work in conjunction with a fingerprint sensor, including  
24 but not limited to electronic circuitry, microchips, elements, conductive layers, and algorithms,  
25 including but not limited to image stitching algorithms;

26 (7) the word “document” includes any written, printed, typed, recorded, computerized,  
27 electronic, taped, graphic, or other matter, in whatever form, whether in final or draft, including but not  
28 limited to all materials that constitute “writings,” “recordings,” “photographs,” “source code” or



“executable code” within the broadest meaning of Rule 1001 of the Federal Rules of Evidence and all materials that constitute “documents” within the broadest meaning of Rule 34 of the Federal Rules of Civil Procedure. The word “document” includes, without limitation, printed matter, electronic mail, materials stored on computer hard drives, diskettes, tapes, any other computer media, and any other information stored magnetically, optically or in any electronic medium and/or form;

(8) the term “communication” includes, without limitation, communications by whatever means transmitted (i.e., whether oral, written, electronic or other methods used), as well as any note, memorandum or other record thereof;

(9) the term “FingerChip” means the fingerprint sensor manufactured by the Atmel Corporation, including but not limited to the fingerprint sensing technologies developed by Jean-Francois Mainguet and incorporated into the FingerChip product.

#### **B. Documents requested.**

The District Court requests the production of the following documents, which are in the possession, custody, or control of **Siemens AG**:

1. Documents relating to or referring to work performed by former or current **Siemens AG** employees Dr. Christofer Hierold, Dr. Thomas Schieter, Dr. Armi Daiss, and Paul-Werner von Basse concerning fingerprint sensors and fingerprint sensing technologies.

2. Documents relating to or referring to **Siemens AG**’s submission for “Deutscher Zukunftspreis 1998.”

3. Documents related to or referring to a **Siemens AG** patent application published by the European Patent Office as EP0044489 and later issued as United States Patent No. 4,394,774.

4. Documents relating to or referring to fingerprint sensors and/or fingerprint sensing technologies consisting of: (1) sensors with a surface area smaller than the surface area of a finger, and/or (2) combining partial fingerprint images to create a more complete fingerprint image, and/or (3) collection of fingerprint data by movement of a finger over a fingerprint sensor, including but not limited to publications, articles, patents, patent applications, schematics, lab notebooks, and manuals.

5. Documents relating to or referring to communications prior to June 5, 1997 between you and Jean-Francois Mainguet, or any other person employed by or associated with Thomson-CSF,

1 concerning fingerprint sensors and fingerprint sensing technologies, including but not limited to  
 2 FingerChip.

3 6. Documents relating to or referring to United States Patent No. 6,289,114 (“the ’114 patent”)  
 4 or United States Patent No. 6,459,804 (“the ’804 patent”) titled “Fingerprint-Reading System.”

5 7. Documents relating to or referring to communications between you and Thomson-CSF,  
 6 Atmel, and/or Thales concerning licensing, offers to license, infringement, invalidity and/or that affect  
 7 in any way rights related to the ’804 patent and/or the ’114 patent.

8 The documents and information requested above are for use as evidence in the Atmel Lawsuit,  
 9 including for use at trial. This Court makes this request to secure production of documents and  
 10 information from **Siemens AG**, which resides in the jurisdiction of Germany, and this Court confirms  
 11 that this is proper and necessary to request since it relates to AuthenTec’s counterclaims and defenses  
 12 and is necessary for a fair resolution of these issues at trial.

13 It is requested that should any portion of this request, or subject questions as described below,  
 14 be denied on legal grounds, that such denial not affect the remainder of this request.

15 It is requested that any evidence produced be marked, attested, properly sealed by the  
 16 appropriate authorities of Germany and returned through appropriate channels to the below signed  
 17 authority

18 Defendant AuthenTec, through counsel Howrey LLP (525 Market Street, Suite 3600, San  
 19 Francisco, California 91405, United States of America, Telephone: (415) 848-4900), will reimburse  
 20 the appropriate judicial authorities in Germany, for all costs incurred in executing the below signed  
 21 judicial authority's request for international judicial assistance.

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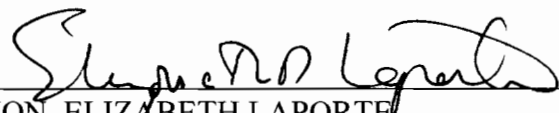
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1 When required, the below signed judicial authority shall provide reciprocal assistance, such as  
2 requested herein, to the appropriate judicial authorities of Germany.

3 The United States District Court for the Northern District of California extends the assurance of  
4 its highest consideration to the judicial authorities of Germany.

5 Date of Request: Sept 14, 2007.

6  
7 By:

  
HON. ELIZABETH LAPORTE  
UNITED STATES DISTRICT COURT JUDGE  
United States District Court  
Northern District of California  
San Francisco Division  
Courtroom E, 15<sup>th</sup> Floor  
450 Golden Gate Avenue  
San Francisco, CA 94102

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